

Remarks

Claims 1-29 and 31 are pending. Claims 1-4, 8-11, 15-18, 22-25, 29 and 31 were rejected under Section 103 as being anticipated by Reed (6426801) in view of Anderson (2001/0033303). Claims 5-7, 12-14, 19-21 and 26-28 were rejected under Section 103 as being obvious over Reed in view of Anderson and Hirai (6493108).

Claim 1 has been amended to recite a processor responsive to a user input to print an index page of thumbnails of plural image files in the same orientation in which each image file was acquired. Similar amendments have been made to Claims 8, 15 and 22.

Reed teaches printing an index page of thumbnail images. Reed does not teach printing the thumbnails in the same orientation in which the image represented by the thumbnail was acquired. Anderson teaches displaying thumbnails on the LCD of a digital camera in the same orientation in which the images represented by the thumbnails were acquired by the camera. The Office asserts that the combination of Reed and Anderson is properly motivated. This assertion is not correct.

Obviousness can only be established by combining references if there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Office must rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office asserts that the combination is motivated "to avoid additional processing (rotating) of portrait images before presentation." The proffered motivation is pure speculation. The Office does not cite to anything in either reference or in the knowledge generally available to those skilled in the relevant art to support its assertion. For this reason alone, the Office has failed to meet its burden of supporting its motivational findings with objective evidence.

Anderson does not teach or even suggest there is any such advantage to presenting the thumbnail images in their "true" orientation. Indeed, Anderson teaches this is an alternative to the preferred embodiment. Anderson, paragraph [0074]. Furthermore, the fact that prior art photo index pages were printed with all

landscape thumbnails suggests that those skilled in the art felt some "processing" efficiency would be lost by printing the thumbnail images in their "true" orientation. Hence, not only is the Office's assertion speculative, it is inconsistent with the teachings of Anderson and the apparent knowledge generally available to those skilled in the art.

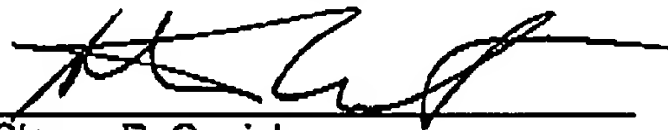
If the Office disagrees, it is respectfully requested to provide objective *evidence* in the references themselves or in the knowledge generally available to those skilled in the art to support its position. Absent such a showing, the rejection of Claims 1, 8, 15, 22 and 29, and their respective dependent claims, should be withdrawn.

Further with regard to Claims 2, 9, 16 and 23, Reed does not teach printing an index page of thumbnails of a selected subset of the image files. The Examiner asserts incorrectly that Reed teaches this limitation at column 7, lines 25-40. The cited passage addresses printing the full size image associated with one or more of the thumbnail images. The cited passage says nothing about printing thumbnail images or index pages containing thumbnail images. In fact, Reed does not teach printing thumbnails of only a subset of the image files. Instead, Reed teaches printing thumbnail images of "all photo on camera card." Block 128 on Fig. 10 and column 7, lines 18-23.

For this additional reason, the rejection of Claims 2, 9, 16 and 23 should be withdrawn..

The foregoing is believed to be a complete response to the outstanding office action.

Respectfully submitted,



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